

REMARKS

This Amendment and Request for Reconsideration is filed in response to the Office Action of June 4, 2004 in which claims 1-15 were rejected and the drawings objected to.

In regard to the objection to the drawings, the changes required by the Examiner have been accomplished by the above amendment and withdrawal of the objection is requested. The Examiner pointing out this error is appreciated.

Regarding the 35 U.S.C. § 102(e) rejection of claims 1-15 as being anticipated by Suumäki et al (U.S. 6,590,905), the Examiner is correct in stating that the applied reference has a common assignee. As such, it does constitute prior art under 35 U.S.C. § 102(e) for purposes of anticipation, but not obviousness because of the so-called "safe-harbor" created by Congress in 1999.

It is correct for the Examiner to state that a rejection under 35 U.S.C. § 102(e) might be overcome by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. However, such a showing of derivation from the present inventor would only be necessary if the 35 U.S.C. § 102(e) rejection were correct in the sense of the presently claimed invention "reading" identically on the Suumäki et al reference.

In reviewing the Examiner's analysis of the independent claims, it should be pointed out that all of the independent claims are similar to independent claim 1 in containing the limitation that a reset signal is provided from the source radio network controller to the user equipment or that a reset acknowledgement signal is sent from the user equipment to the source radio network controller (see claim 6 for example). In claim 9, it is clear that the reset signal is sent from the source radio network controller to the user equipment.

In claim 14, it is also clear that the claimed radio network controller both decides to perform relocation, provides a reset signal to the user equipment and receives a reset acknowledge signal from the user equipment. Such is not the

case in Fig. 5 of the Summäki et al reference where the source SRNC is not shown having anything to do with sending the reset request or receiving the reset confirmation from the user equipment.

Claim 15 is the only claim where it is not explicitly clear that the source RNC provides the reset signal to the UE and receives back confirmation therefrom. Therefore, claim 15 has been amended to make this clear.

The passages cited by the Examiner at column 4, lines 12-21 have to be read in conjunction with both Fig. 5 and the statement in column 4, lines 8-12 that it is the duty of the target SRNC to execute all specific PDCCP parameter set up procedures. Thus, the passage cited by the Examiner at column 4, lines 12-21 means that the target SRNC takes care of sending the reset request and receives the reset confirm as illustrated in Fig. 5 of Summäki et al. This is different from what is claimed in the independent claims hereof wherein the reset signal is sent from the source radio network controller to the user equipment.

It is also the case that the specific steps and corresponding means recited in the claims are not explicitly shown by Summäki. For instance, there is no step or means for deciding shown at a source radio network controller to perform relocation of the control of the communication link to a target radio network controller. Neither the passage cited at column 2, lines 1-9 nor at column 3, lines 57-64 disclose means for deciding.

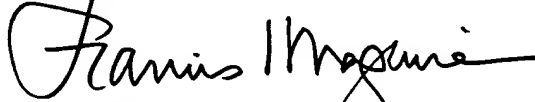
Therefore, Summäki et al is unavailable as a 35 U.S.C. § 102(e) reference against claims 1-15 and withdrawal of the rejection of those claims on that ground is requested.

It should be pointed that Summäki et al is unavailable as a 35 U.S.C. § 102(e)/103 reference on account of the amendment to Subsection (c) of § 103 amended November 29, 1999, Public Law 106-113, § 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 § 4807).

The present application is commonly owned with the Summäki reference and therefore the provisions of 35 U.S.C. § 103(c) are applicable and therefore a U.S.C. § 103 rejection of claims 1-15 is not available.

The objections and rejections of the Official Action of June 4, 2004, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims 1-15 to issue is solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Francis J. Maguire". The signature is fluid and cursive, with a large loop at the end.

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FIG. 5A
PRIOR ART

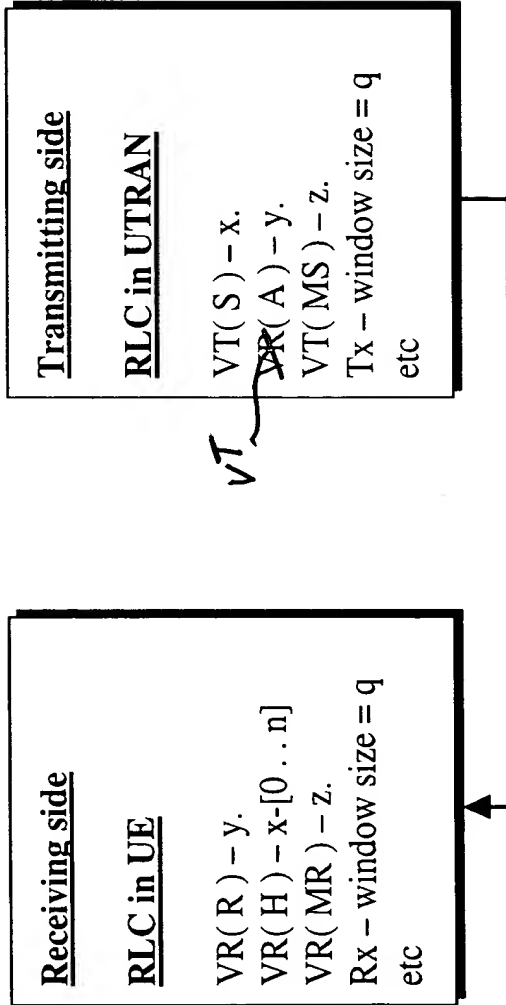


FIG. 5B
PRIOR ART

